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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,487	10/20/2003	Thomas W. Davison	1291.1134103	7935
33469 7590 06/21/2011 SEAGER, TUFTE & WICKHEM, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420				
EXAMINER WOODALL, NICHOLAS W				
ART UNIT		PAPER NUMBER		
3775				
MAIL DATE		DELIVERY MODE		
06/21/2011		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/689,487

Applicant(s)

DAVISON, THOMAS W.

Examiner

Nicholas Woodall

Art Unit

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-23, 25-27, 30-36, 38-41 and 46-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27, 30-36, 38-41, 47 and 48 is/are allowed.
- 6) ☒ Claim(s) 18-23, 25, 26 and 46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to applicant's amendment after BPAI decision received on May 27th, 2011.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 18-23, 25, 26, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foley (U.S. Patent 5,792,044) in view of Ash (WO 8303189 A1) and Zdeblick (U.S. Patent 6,206,922).

Regarding claims 18-23, 25, 26, and 46, Foley discloses a system comprising an elongated body that can be useable with at least two fasteners (column 15 lines 3-20) and an elongated viewing element, which can be mounted to the elongated body (column 5 lines 51-65). The elongated body defines an unobstructed access path between the proximal end and the distal end. Foley fails to disclose a system comprising an elongated body that is expandable at the distal end at a first location and the system further comprising a fixation element with at least two fasteners capable of being passed through the passage of an elongate element. Ash teaches a device for use in minimally an invasive surgical procedure that comprises an elongated body that is expandable at the distal end in order to provide viewing and operation room (page 2 lines 24-35). Zdeblick teaches a system comprising a fixation element capable of being

passed through the passage of an elongate element in order to fuse to adjacent vertebrae. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Foley wherein the elongate body with an expandable distal end in view of Ash and further comprising a fixation element with at least two fasteners capable of being passed through the passage of an elongate element in view of Zdeblick in order to provide viewing and operation room and to fuse two adjacent vertebrae.

Further regarding claim 18, the combination of Foley, Ash, and Zdeblick disclose a device wherein the cross-sectional area of the second configuration of the passage at the distal end of the device is capable of providing visualization of two fasteners fixed to two adjacent vertebrae. The examiner believes that the combination having an expandable distal end is capable of allowing a surgeon to view two fasteners fixed to two adjacent fasteners. There is no limitation regarding the viewing of the screws being simultaneously viewed, but the examiner believes that the combination is capable of providing simultaneous viewing of the two fasteners as well. Regarding claims 23 and 36, the combination of Foley, Ash, and Zdeblick disclose a device wherein the at least two fasteners are pedicle screws. The screws of the Zdeblick reference are capable of being inserted into the pedicle and can be interpreted as such. Regarding claim 25, the combination of Foley, Ash, and Zdeblick disclose a device wherein the fixation element is a rod. The fixation element of Zdeblick is a rod-shaped element that can be interpreted as a rod.

Response to Arguments

4. Applicant's arguments filed May 27th, 2011 have been fully considered but they are not persuasive. The applicant's argument that Ash reference does not disclose a device wherein the passage is unobstructed in the second configuration is not persuasive. First, the applicant's argument is based on a piece-meal analysis of the rejection and does not take into account the disclosures of the other references. Furthermore, one cannot show non-obviousness by attacking references individually when the rejections are based on combinations of references. Second, the Foley reference clearly discloses an elongated tube defining a passage as discussed above, wherein the passage provides unobstructed access from the proximal end of the member to the distal end of the member. Therefore, the Ash reference does not need to teach the passage way being unobstructed since the limitation is already disclosed in the Foley reference. Third, the Ash reference does disclose an elongated member defining a passage that is unobstructed from the proximal end to the distal end when in an expanded configuration, wherein the cross-section of passage defined by elements 28 in the second configuration is larger than the cross-section of the passage defined by the tube 12. The applicant argues that the passage of the Ash reference includes structures and elements, such as 34 and 24, thereby obstructing the passage. These structures and elements are not part of the passage, but are placed within the passage which gives these structures and elements unobstructed access from the proximal end of the elongate member to the distal end of the elongate member in the second configuration as shown clearly in Figure 2. If the device of Ash did not have an

unobstructed passage from the proximal end to the distal end of the elongate member, then those structures and elements would not be able to perform any functions on the patient.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3775

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/
Primary Examiner, Art Unit 3775